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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Ivarie, et al.
Serial No. : 10/696,671
Filed : October 28, 2003
Issued : April 21, 2009
Patent No. : 7,521,591
Title : TRANSGENIC CHICKENS THAT LAY EGGS CONTAINING
EXOGENOUS PROTEINS

Art Unit : 1633

Examiner : 6850

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Date May 15, 2009
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Name Kyle Vastard

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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 101 to 217 days, is respectfully requested.

REMARKS

"A Delays" are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. "B Delays" are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can "overlap" is if they occur on the same day. If an "A delay" occurs on one calendar day and a "B delay" occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

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Page 1 of 5

Applicant : Ivarie, et al.
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Issued : April 21, 2009
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The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years." "B delay" begins only after the PTO has failed to issue a patent within three years, not before. Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

"A Delay"

A first PTO action was due on or before December 28, 2004 (the date that is fourteen months after October 28, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on August 9, 2005, thereby according a PTO Delay of 224 days. Patentee does not dispute the PTO's calculation for this "A Delay" from December 29, 2004 (the day after the date that is fourteen months after the date on which the application was filed), to August 9, 2005. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of "A Delay" detailed above, the total "A Delay" for this patent should be calculated as 224 days.

"B Delay"

The period beginning on October 29, 2006 (the day after the date that is three years after October 28, 2003, the date on which the application was filed), and ending April 21, 2009 (the date the patent was issued), is 906 days in length.

"B Delay" may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, a Request for Continued Examination was filed on February 21, 2007, and the patent issued on April 21, 2009, resulting in a period of 790 days that must be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

Applicant : Ivarie, et al.
Serial No. : 10/696,671
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In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed.
See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 116 days (i.e., 906 days minus 790 days). The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 116 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:

December 29, 2004 to August 9, 2005.

As detailed above, "B Delay" accumulated during the following period:

October 29, 2006, to February 21, 2007.

As such, the periods of "A Delay" and "B Delay" do not overlap (i.e., occur on the same calendar day).

Applicant Delay

A reply to an Office Action was due on or before January 19, 2006 (the date that is three months after October 19, 2005, the date on which the Office Action was mailed). Patentec filed a response to the Office Action on January 23, 2006, thereby according an Applicant Delay of 4 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from January 20, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to January 23, 2006. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before July 20, 2006 (the date that is three months after April 20, 2006, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on September 21, 2006, thereby according an Applicant Delay of 63 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from

Applicant : Ivarie, et al.
Serial No. : 10/696,671
Filed : October 28, 2003
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Patent No. : 7,521,591

July 21, 2006 (the day after the date that is three months after the date on which the Office Action was mailed), to September 21, 2006. See 37 C.F.R. § 1.704(b).

Patentee filed an Information Disclosure Statement on September 25, 2006, subsequent to a reply filed on September 21, 2006. Patentee was accorded a delay of 4 days for a supplemental response. Patentee does not dispute the PTO's calculation for this Applicant Delay from September 22, 2006, to September 25, 2006. See 37 C.F.R. § 1.704(c)(8).

Patentee filed an Information Disclosure Statement on October 27, 2006, subsequent to a reply filed on September 25, 2006. Patentee was accorded a delay of 32 days for a supplemental response. Patentee does not dispute the PTO's calculation for this Applicant Delay from September 26, 2006, to October 27, 2006. See 37 C.F.R. § 1.704(c)(8).

A reply to an Office Action was due on or before February 15, 2008 (the date that is three months after November 15, 2007, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on March 6, 2008, thereby according an Applicant Delay of 20 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from February 16, 2008 (the day after the date that is three months after the date on which the Office Action was mailed), to March 6, 2008. See 37 C.F.R. § 1.704(b).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 123 days (i.e., the sum of 4 days, 63 days, 4 days, 32 days, and 20 days).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 101 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 340 days (i.e., the sum of 224 days of "A Delay" and 116 days of "B Delay");

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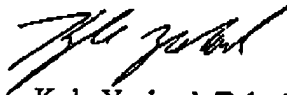
MAY 15 2009

2) Total Applicant Delay should be calculated as 123 days (i.e., the sum of 4 days, 63 days, 4 days, 32 days, and 20 days); and

3) Total PTA should be calculated as 217 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No 501729, referencing attorney docket number AVI-000CON.

Respectfully submitted,



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